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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>	Docket Number (Optional) <b>SNK-3750US3</b>	
	Application Number <b>10/712,087</b>	Filed <b>November 13, 2003</b>
	First Named Inventor <b>Kazuhisa YAMAMOTO et al.</b>	
	Art Unit <b>2828</b>	Examiner <b>Tod Thomas Van Roy</b>

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.7.1 Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number **34,515**

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

**Lawrence E. Ashery**

Typed or printed name

**610-407-0700**

Telephone number

**January 5, 2009**

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of **1** forms are submitted

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Claims 78-80 and 82-85 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto (U.S. 5,303,247) in view of Rakuljic (U.S. 5,691,989). It is respectfully submitted, however, that these claims are patentable over the art of record for the reasons set forth below.

As explained in the above-identified application, Appellants' claims relate to a laser light source. The laser light source includes a laser, a laser amplifier, and an optical wavelength conversion element. Appellants' claim 78 defines the optical wavelength conversion element as being formed:

... with a stable proton exchange layer whose refractive index is constant at an ordinary temperature more than one day immediately after the optical wavelength conversion element is formed.

The above feature is supported by the originally filed application at page 33, line 26, through page 34, line 13, and by Fig. 13. In particular, as set forth in the originally filed application at page 34, lines 1-4:

It can be seen from these figures that the refractive index variation and the phase-matched wavelength become constant immediately after production of the element.

By contrast, in the Yamamoto prior art patent, the optical wavelength conversion element has a refractive index which varies with time after the optical wavelength conversion element is formed. Thus, Appellants' claimed feature of a refractive index which is constant "more than one day immediately after the optical wavelength conversion element is formed" is neither disclosed nor suggested by Yamamoto.

Page 4 of the outstanding Official Action argues that the Yamamoto prior art patent discloses a refractive index which does not vary with time during operation. To support this position, the Official Action cites the Yamamoto prior art patent at Column 23, line 66, through Column 24, line 16. Appellants' representative has reviewed the aforementioned lines of the Yamamoto prior art patent and has not found any disclosure of a refractive index which is constant "more than one day

immediately after the optical wavelength conversion element is formed." To further support Appellants' position, Appellants' representative timely filed a Rule 132 Declaration which was signed by Dr. Yamamoto. Dr. Yamamoto is an inventor of the above-identified application. Dr. Yamamoto is also one of the listed inventors of the Yamamoto prior art patent.

In his Declaration, Dr. Yamamoto asserts that :

... one of ordinary skill in the art associated with the '247 patent would completely disagree with an understanding that the refractive index of the optical wavelength conversion element of the '247 patent does not vary with time after the optical wavelength conversion element is formed.

Dr. Yamamoto further takes the position that one of ordinary skill in that art corresponding to the '247 patent would understand that the optical wavelength conversion element of the '247 patent does not have the feature of:

... the refractive index is constant at an ordinary temperature more than one day after the optical wavelength conversion element is formed ...

In addition, Dr. Yamamoto states in his declaration that:

... the optical wavelength conversion element of the '247 patent changes in the manner illustrated by Fig. 4, Fig. 5 and Fig.6 of the above-identified application and in the manner described in the text of the above-identified application which corresponds to Figs. 4, 5 and 6.

Thus, the above-identified application provides graphs that indicate that the proton exchange layer of the Yamamoto prior art patent has a refractive index which varies more than one day after the optical wavelength conversion element has been formed.

Thus, Dr. Yamamoto has taken a position which contradicts the position set forth in the outstanding Official Action regarding the refractive index of the proton exchange layer being constant. The following case law is particularly on point:

It is difficult to give credence to the patent office's position when the inventor of the invention cited as pertinent disagrees with its applicability.

Bowled Fluidics Base Corp. v Mossinghoff, 620 F. Supp. 1297 (D.D.C. 1985). Accordingly, on the basis of Dr. Yamamoto's Declaration, the rejection of claim 78 should be withdrawn.

The Rakuljic reference does not make up for the deficiencies of the Yamamoto prior art patent as being used in rejecting Appellants' claims. Furthermore, claims 79, 80 and 82-85 are patentable by virtue of their dependency on allowable claim 78. Accordingly, claims 78-80 and 82-85 are patentable over the art of record.

Of particular concern to Appellants' representative is the fact that evidence traversing the rejection was ignored by the USPTO despite the fact that the evidence was timely filed.

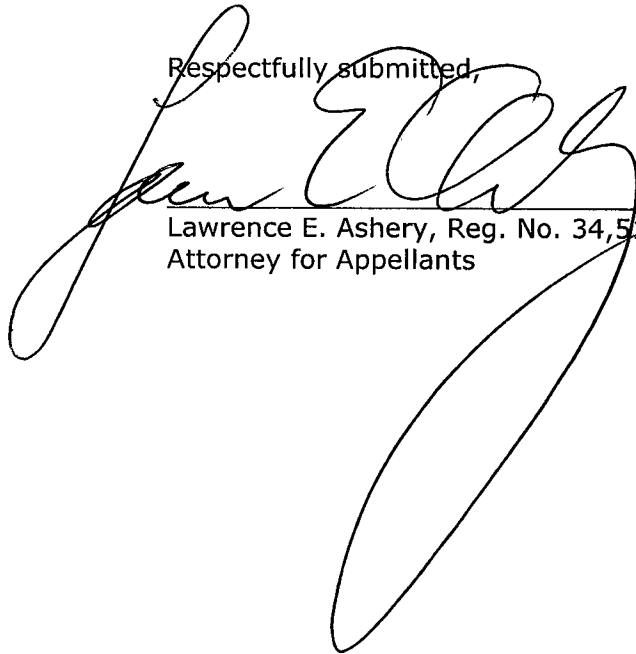
Affidavits or declarations, when timely presented, containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the Examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. § 103 ... as indicia of obviousness or unobviousness, such evidence may have relevancy. MPEP 716.01(a)

When Appellants' representative says "ignored," Appellants' representative means that the outstanding Official Action contains absolutely no mention of the fact that a Rule 132 Declaration had been filed. Appellants' Declaration is entitled to consideration. Hence, the present request for Pre-Appeal Conference has been filed.

Claim 90 is newly added and is supported by the originally filed application at page 67, lines 28-29. Claim 91 is newly added and is supported both by Appellants' Fig. 13 and page 26, line 16, through page 27, line 26. No new matter has been added.

In view of the amendments and arguments set forth above, and further in view of the previously filed Declaration, allowance of the above identified application is respectfully requested.

Respectfully submitted,



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Dated: January 5, 2009

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